



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,445	11/20/2000	Warren Adams	249768040US	2880

25096 7590 06/01/2005

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER

JASMIN, LYNDIA C

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,445

Applicant(s)

ADAMS ET AL.

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-43 and 67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-43 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

41

DETAILED ACTION

1. Amendment received March 03, 2005 has been acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 25-28, 31, 33-43 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (6,611,814 B1) in view of Nelson et al. (200/0042775 A1).

Lee et al. discloses a method in a computing system (via an online store) for notifying a first customer (via recipient 140 which is also a shopper allowing other shoppers and online store to use their wish list) about a purchase made by a second customer (shoppers 101 which could also be a list owner), including: detecting that the

Art Unit: 3627

second customer has purchased an item has purchased an item for a person other than the first customer (via a shopper purchasers products for other people) (col. 12, lines 37-41), determining that the first customer (recipients 140) has a purchase notification relationship with the second customer (via list of recipient prepare by shoppers 101; col. 11, lines 57-67). Lee et al. further discloses receiving an order from the second customer for the item (via checkout process, col. 13, lines 11-12), receiving an order from a third customer (via another shopper) ordering the item as a gift for the second customer (col. 12, lines 18-21). Lee et al. also discloses establishing for the first customer a purchase notification relationship with the second customer in response to an instruction from the first/second customer (via the creation of a recipient list of which owns wish list on the server), and establishing for the first customer a purchase notification relationship with the second customer in response to a comparison of characteristics of the first and second customers (col. 6, lines 19-35).

As per claim 43, Lee et al. further discloses the purchase detection subsystem (via the checkout process step 216) detects that the second customer has purchased an item for a recipient other than the first customer (since one or more persons are on the customer recipient list 702 via receivers 140) (further, as illustrated in Figure 8, the shopper 101, viewed as the second customer, can make transactions for purchasing one or more product from their owned wish list) (col. 12, lines 12-26), a purchase notification relationship subsystem (via online store 120) that determines that the first customer has a purchase notification relationship with the second customer (col. 6, lines 42-53).

However, Lee et al. fails to explicitly disclose providing to the first customer a notification identifying that the second customer has purchased the item, and receiving input from the second customer indicating that the second customer owns the item.

Nelson et al. discloses the concept of notifying a recipient of purchased made by a purchaser (114) and identifying the purchaser to the recipient (110; is implied via sending a gift card). The notifying concept is via gift card electronically generated and sent in an e-mail message, or the notification may be via an e-mail message that is transmitted to the recipient, or a physical gift card provided (such as via postal mail gift card). Nelson et al. further discloses an input via payment mechanism that the purchaser has paid for the transaction and an invoice is generated. Nelson et al further discloses determining if an initial payment is required for the commodity before completed the process of registering for a registry which could be viewed as the recipient being also the purchaser by making a down payment for the commodity. List of items either available or unavailable can be viewed at client computer (122) via exchanging information with server computer (126).

From this teaching of Nelson et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the users online store and wish list of Lee et al. to include notifying of the receiving user as taught by Nelson et al. in order to indicate that a product has been purchased and thereby delete it or put the product unavailable from a wish list.

5. Claims 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. in view of Nelson et al., and further in view of Ewing (202/0095298 A1).

The Lee et al. and Nelson et al. combination discloses all the elements of the claimed invention but fails to explicitly disclose the common and well-known variation of sending messages via instant message, pager message and voice mail message.

Ewing discloses the concept of having member interacting with other members over the internet using text, audio or voice chat; instant messaging; or, e-mail, and the member desires to send the other member a gift.

From this teaching of Ewing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the Lee et al. and Nelson et al. combination to include the different ways of sending notification message to another party as taught by Ewing in order to engage in real time conversation.

Response to Arguments

6. Applicant's arguments filed March 03, 2005 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., teach "a purchase notification relationship between the first customer and the second customer, where the purchase notification relationship causes the first customer to receive a notification of the second customer's purchase of the item for someone other than the first customer") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, the Nelson et al. prior art, discloses the concept of having a notification, which may be in the form of gift card, or may be an e-mail message transmitted to the recipient, thus one of ordinary skill in the art would know that a gift card bears the identification of the sender and the amount contributed. Thus, sending a notification, which identifies the sender, is implied in the Nelson reference. Therefore, the rejection of Lee et al. in view of Nelson et al. has not been withdrawn.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Robertson discloses the concept of having service provider notifying users that a purchase of a product or an event has been performed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

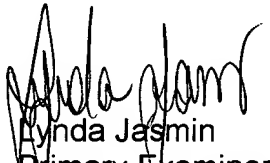
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627